

REMARKS/ARGUMENTS

In response to the Office Action dated October 22, 2003, claims 1, 6, 8 and 16 are amended, and claims 4 and 5 are cancelled. Claims 1-3 and 6-20 are now active in this application. No new matter has been added.

REJECTION OF CLAIMS UNDER 35 U.S.C. § 102 AND § 103

I. Claims 1-3, 5, 8, 9 and 11-18 are rejected under 35 U.S.C. § 102(e) as being anticipated by Dimsdale et al. (US 2003/0001835).

To expedite prosecution, claims 5 is canceled and independent claim 1 is amended to delineate, *inter alia*:

an imaging section for taking a two-dimensional image of the object,
wherein the display section displays information about an area where the scanning has been completed by the measuring section in accordance with a progress of the scanning by displaying the two-dimensional image of the object and identifiably showing an area of the two-dimensional where the scanning has already completed as well as an area where the scanning has not completed yet.

Independent claim 8 is amended to recite:

A three-dimensional shape measuring system comprising:
a measuring section for measuring a three-dimensional shape of an object by scanning the object;
an imaging section for taking a two-dimensional image of the object including an area to be measured by the measuring section; and
a display section for displaying the two-dimensional image of the object taken by the imaging section and identifiably showing an area of the two-dimensional image where the scanning has already completed as well as an area where the scanning has not completed yet based on a degree of progress in the measuring section.

Dimsdale et al. does not disclose or suggest displaying the two-dimensional image of the object (being scanned) and identifiably showing both an area of the two-dimensional image

where the scanning has already completed as well as an area where the scanning has not completed yet. More specifically, there is no single two-dimensional image that is displayed in Dimsdale et al. which shows both these required features, as not required by amended claims 1 and 8.

Independent claim 16 is amended to include the limitation:

an inquiry section for inquiring of a user as to whether or not previous measured data are saved when the instructing the stop of measuring by the measuring section is received.

Dimsdale et al. neither discloses nor suggests inquiring of a user as to whether or not previous measured data are saved when the instruction stop measuring by the measuring section is received.

Thus, amended independent claims 1, 9 and 16, as well as dependent claims 2, 3, 9, 11-15, 17 and 18, are patentable over Dimsdale et al. and their allowance is respectfully solicited.

II. Claims 16, 19 and 20 are rejected under 35 U.S.C. § 102(e) as being anticipated by Yamamoto et al. (USPN 5,862,252).

Yamamoto et al. neither discloses nor suggests inquiring of a user as to whether or not previous measured data are saved when the instruction stop measuring by the measuring section is received, as now recited in amended independent claim 16.

Thus, amended independent claim 16, as well as dependent claims 19 and 20, are patentable over Yamamoto et al. and their allowance is respectfully solicited.

III. Claims 1, 4, 8 and 10 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Ritter et al. (USPN 6,363,169) in view of Cohen et al. (USPN 6,222,937). The Examiner contends that Ritter et al. discloses the claimed invention except for displaying information about an area where the scanning has been completed by the measuring section. The Examiner maintains that Cohen et al. discloses a system for measuring 3D shape of an object and teaches displaying information about an area where the scanning has been completed by the measure section (figure 7; “the user interface displays a representation of the stage 701 with a translucent hemisphere 702 surrounding the object” and “the user interface displays an indication of the different orientations from which pictures have been taken on the surface of the hemisphere” at column 7, lines 44-48).”

However, amended independent claims 1 and 8 require displaying the two-dimensional image *of the object* (being scanned) and identifiably showing an area of the two-dimensional image where the scanning has already completed as well as an area where the scanning has not completed yet in order to display information about an area where the scanning has been completed by the measuring section in accordance with a progress of the scanning.

The indication in Fig. 7 of Cohen et al. as to different orientations from which pictures (of the object being photographed) have been taken on the surface of the hemisphere is not *a two-dimensional image of the object being scanned*, as required by amended claims 1 and 8, and does not identifiably showing an area of the two-dimensional image where the scanning of the object has already completed. Thus, Ritter et al. and Cohen et al., considered alone or in combination, do not disclose or suggest the features recited in amended independent claims 1 and 8. Consequently, amended independent claims 1 and 8, as well as dependent claim 10, are patentable over Ritter et al. and Cohen et al., and their allowance is respectfully solicited.

IV. Claims 6 and 7 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Dimsdale et al. in view of Akins et al. (USPN 5,309,555). The Examiner admits that Dimsdale et al. does not teach displaying a message indicating the degree of progress as a percentage. The Examiner maintains that Akins et al. discloses a system for processing and transmitting images, comprising display a message indicating the degree of progress as a percentage, and contends that it would have been obvious to one of ordinary skill in the art to modify the display of Dimsdale according to the teaching of Akins et al. to meet the terms of these claims.

The rejections are respectfully traversed.

Applicant stresses that the requisite motivation to support an obviousness conclusion is not an abstract concept, but must stem from the prior art as a whole to impel one having ordinary skill in the art to modify a reference or combine references with a reasonable expectation of successfully achieving some particular realistic objective. See, for example, *In re Gyurik*, 596 F.2d 1012, 201 USPQ 552 (CCPA 1979). Consistent legal precedent admonishes against the indiscriminate combination of prior art references. *Carella v. Starlight Archery*, 804 F.2d 135, 231 USPQ 644 (Fed. Cir. 1986); *Ashland Oil, Inc. v. Delta Resins & Refractories, Inc.*, 776 F.2d 281, 227 USPQ 657 (Fed. Cir. 1985); *ACS Hospital Systems, Inc. v. Montefiore Hospital*, 732 F.2d 1572, 221 USPQ 929 (Fed. Cir. 1984); *In re Ehrreich*, 590 F.2d 902, 200 USPQ 504 (CCPA 1979).

It is Applicants' position that the Examiner has not articulated any logical reason why one having ordinary skill in the art would have been motivated to modify and/or combine the applied references to arrive at the claimed invention.

The Examiner states that the display of Dimsdale et al. "displays the 3D data according to the progress of the process of the scanning". As further noted by the Examiner, Akins et al.

discloses that “a status message at the bottom of the Telesketh primary window displays “percentage done” progress indicators so that users can see how far along the transmission has progressed” at column 12, line 40.” The transmission described at column 12, line 40 refers to the transmitting of a file to a remote Telesketh program. There is nothing with regard to displaying how far along the transmitting of a file to a remote Telesketh program is, which is remotely related to displaying information/message indicating the status/degree of progress of scanning an object for measuring the three-dimensional shape of the object.

In view of the disparate subject matter of transmitting of a file to a remote Telesketh program and of scanning an object for measuring the three-dimensional shape of the object, it is not apparent whence stems the requisite motivation for one having ordinary skill in the art to zero in on the status message at the bottom of the Telesketh primary window displaying (percentage done) progress as to how far along the transmission of a file to a remote Telesketh program has progressed, and insert this into the arrangement of Dimsdale et al. while converting it to display information/message indicating the status/degree of progress of scanning an object for measuring the three-dimensional shape of the object, which is neither disclosed or suggested in either Dimsdale et al. nor Akins et al.

Frankly, the only apparent motivation of record for the proposed modification of the arrangement of Dimsdale et al. with the teaching of Akins et al. to arrive at the claimed inventions is found in Applicants’ disclosure which, of course, may not properly be relied upon to support the ultimate legal conclusion of obviousness under 35 U.S.C. §103. *Panduit Corp. v. Dennison Mfg. Co.*, 810 F.2d 1561, 227 1 USPQ2d 1593 (Fed. Cir. 1987). Thus, the Examiner has not established the requisite motivation for the proposed combination of references to arrive at the claimed invention.

It is, therefore, respectfully submitted that the rejection of claims 6 and 7 under 35 U.S.C. § 103(a) as being unpatentable over Dimsdale et al. in view of Akins et al. is an example of improper reconstruction of the claimed invention using the present disclosure as a guide. Accordingly, withdrawal of the rejection of claims 6 and 7 under 35 U.S.C. § 103 is respectfully solicited.

To expedite prosecution, claim 6 is amended to be in independent form including all the limitations of original base claim 1. Consequently, the allowance of claims 6 and 7 is respectfully solicited.

CONCLUSION

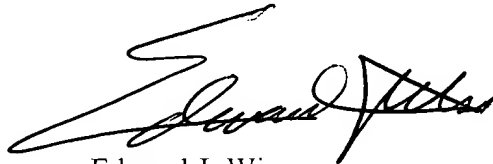
Accordingly, it is urged that the application, as now amended, is in condition for allowance, an indication of which is respectfully solicited. If there are any outstanding issues that might be resolved by an interview or an Examiner's amendment, Examiner is requested to call Applicants' attorney at the telephone number shown below.

09/748,138

To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 500417 and please credit any excess fees to such deposit account.

Respectfully submitted,

McDERMOTT WILL & EMERY

A handwritten signature in black ink, appearing to read 'Edward J. Wise', with a stylized, flowing script.

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